Hovsepian v. Apple, Inc. Doc. 281

HENNIGAN, BENNETT & DORMAN LLP
RODERICK G. DORMAN (CA SBN 96908)
dormanr@hbdlawyers.com
ALAN P. BLOCK (CA SBN 143783)
blocka@hbdlawyers.com
MARC MORRIS (CA SBN 183728)
morrism@hbdlawyers.com
601 South Figueroa Street, Suite 3300
Los Angeles, California 90017
Telephone: 213-694-1200
Facsimile: 213-694-1234

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. 05 CV 01114 JW MDL No. 1665 **NOTICE OF COMPLIANCE BY ACACIA WITH CASE MANAGEMENT ORDER NARROWING DISPUTED CLAIMS**

Dockets.Justia.com

TO ALL PARTIES AND TO THE COURT:

PLEASE TAKE NOTICE that Acacia has complied with the Court-ordered stipulation of the parties and has notified defendants of further patent claims it will not assert in this litigation, thereby mooting a substantial number of motions which the defendants propose to file.

A copy of the letter sent to all counsel is attached to this Notice.

Dated: May 16, 2008

RODERICK G. DORMAN (CA SBN 96908)
ALAN P. BLOCK (CA SBN 143783)
MARC MORRIS (CA SBN 183728)
HENNIGAN, BENNETT & DORMAN LLP
601 South Figueroa Street, Suite 3300
Los Angeles, California 90017

By /S/ Roderick G. Dorman
Roderick G. Dorman

Attorneys for Plaintiff
ACACIA MEDIA TECHNOLOGIES CORPORATION

ATTACHMENT

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
865 SOUTH FIGUEROA STREET
SUITE 2900
LOS ANGELES, CALIFORNIA 90017
TELEPHONE (213) 694-1200
FACSIMILE (213) 694-1234

DIRECT PHONE (213) 694-1006
DORMANR@HBDLAWYERS.COM

May 16, 2008

VIA E-MAIL

TO ALL COUNSEL OF RECORD

Re: ***In re Acacia Media Technologies***
No. C 05-1114 (MDL 1665)

Dear Counsel:

As you are aware, Acacia initially asserted the following claims against one or more defendants:

- Claims 1-24, 41-49, and 51-53 of U.S. Patent No. 5,132,992 (the '992 patent);
- Claims 2 and 5 of U.S. Patent No. 5,253,275 (the '275 patent);
- Claims 14-19 of U.S. Patent No. 5,550,863 (the '863 patent);
- Claims 4, 6-8, and 11 of United States Patent No. 6,002,720 (the '720 patent); and
- Claims 1-42 of U.S. Patent No. 6,144,702 (the '702 patent).

During the claim construction phase of the case, Acacia withdrew claims 1-18 of the '992 patent with respect to the Internet defendants and withdrew claims 23, 24, 47, 48, 49, 51, 52, and 53 of the '992 patent with respect to all defendants. Acacia provided stipulated covenants not to sue on each of those claims.

Recently, in response to defendants' lists of proposed Section 112 motions and based on the Court's claim construction rulings, Acacia stated that it would not oppose defendants' proposed motion nos. 1, 2, 3, 5, and 10-12 of Mr. Benyacar's March 28 letter and proposed motion nos. 1 and 4 of Mr. Kreeger's March 28 letter. As a result, all of the claims asserted by Acacia are invalid, based on the Court's constructions, as evidenced by Acacia's stipulation of April 4.

At the May 9 Case Management Conference, the Court directed Acacia to determine whether it could eliminate as many of the remaining proposed section 112 motions as possible. Accordingly, pursuant to the Court's direction, Acacia will withdraw the following claims and will provide defendants with a covenant not to sue on such claims:

- Claims 19-22 and 42-44 of the '992 patent;
- Claims 2 and 5 of the '275 patent;
- Claims 14-16 of the '863 patent; and
- Claims 4 and 6-8 of the '720 patent.

We will provide you with a stipulated covenant not to sue on these claims in the same form that we previously have jointly executed. Further, we will provide a new form of Stipulated Covenant Not to Sue and Order Thereon to conform to the requirements of the Order to be included with the stipulation prescribed by the Court at our last hearing for both these patent claims and those contained in the earlier stipulation.

The withdrawal of these claims by Acacia reduces the number of proposed Section 112 motions which remain in dispute. It is our understanding that the following proposed Section 112 motions are mooted by Acacia's withdrawal of the above-identified claims: Proposed Motion Nos. 6, 13, 18, 22, 27, 28, 29, 30, 31, 34, and 35 of Mr. Benyacar's March 28 letter.

Thus, at this time, only the following proposed Section 112 motions remain in dispute:

- Proposed Motion Nos. 4, 7, 8, 9, 14, 15, 16, 17, 19, 20, 21, 23, 24, 25, 26, 32, and 33 of Mr. Benyacar's March 28 letter; and
- Proposed Motion Nos. 1, 2, 4, 5, and 6 of Mr. Kreeger's April 11 letter. (note that Mr. Kreeger changed the identifying number of each of his proposed motions between his March 28 letter and his April 11 letter).

Acacia's withdrawal of these claims is done without prejudice to Acacia bringing a motion for summary judgment under Rule 56(a) that all of the currently asserted claims are invalid based on the Court's claim constructions; without prejudice to Acacia's contentions that all of defendants' counterclaims and the issues presented in the remaining, listed motions of Messrs. Benyacar and Kreeger are moot in light of Acacia's stipulation that all of the asserted patent claims are invalid; and without prejudice to Acacia seeking a final judgment that all of the asserted claims are invalid based on the Court's claim construction and dismissing without prejudice defendants' counterclaims, as Acacia set forth in its portion of the Joint Case Management Statement and at the Case Management Conference on May 9.

Very truly yours,

Roderick G. Dorman
of Hennigan, Bennett & Dorman LLP

RGD:APB:csy

PROOF OF SERVICE-UNITED STATES DISTRICT COURT

STATE OF CALIFORNIA,)
) SS.
COUNTY OF LOS ANGELES)

I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action; my business address is 865 South Figueroa Street, Suite 2900, Los Angeles, California 90017.

On **May 16, 2008**, I served a copy of the within document(s) described as **NOTICE OF COMPLIANCE BY ACACIA WITH CASE MANAGEMENT ORDER NARROWING DISPUTED CLAIMS** on the interested parties in this action by transmitting via United States District Court for the Northern District of California Electronic Case Filing Program the document listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

Chambers of the Honorable James Ware Attn: Regarding Acacia Litigation 280 South First Street San Jose, CA 95113 ***3 copies***	

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

Executed on **May 16, 2008,** at Los Angeles, California.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/S/ Carol S. Yuson
Carol S. Yuson

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

SERVICE LIST

Juanita R. Brooks Todd G. Miller Fish & Richardson 12390 El Camino Real San Diego, California 92130-2081 ***Counsel for:*** ***ACMP LLC; Ademia Multimedia LLC; Adult Entertainment Broadcast Network; Adult Revenue Services; Audio Communications; CJ Inc.; Club Jenna Inc.; Cyber Trend Inc.; Cybernet Ventures Inc.; Game Link Inc.; Global AVS Inc.; Innovative Ideas International; Lightspeedcash; National A-1 Advertising Inc.; New Destiny Internet Group LLC; VS Media Inc.***	Jonathan E. Singer William R. Woodford Fish & Richardson 60 South Sixth Street, Suite 3300 Minneapolis, Minnesota 55402 ***Counsel for:*** ***ACMP LLC; Ademia Multimedia LLC; Adult Entertainment Broadcast Network; Adult Revenue Services; Audio Communications; CJ Inc.; Club Jenna Inc.; Cyber Trend Inc.; Cybernet Ventures Inc.; Game Link Inc.; Global AVS Inc.; Innovative Ideas International; Lightspeedcash; National A-1 Advertising Inc.; New Destiny Internet Group LLC; VS Media Inc.***
Victor De Gyarfas William J. Robinson Foley & Lardner 2029 Century Park E, 35th Floor Los Angeles, California 90067 ***Counsel for:*** ***International Web Innovations, Inc.***	Gary A. Hecker James Michael Slominski Hecker Law Group 1925 Century Park East, Suite 2300 Los Angeles, California 90067 ***Counsel for:*** ***Offendale Commercial Limited BV***
Mark D. Schneider Gifford, Krass, Groh, Sprinkle, Anderson and Citkowski 280 N. Old Woodward Avenue, Suite 400 Birmingham, Michigan 48009-5394 ***Counsel for:*** ***Askcs.com Inc.***	Alfredo A. Bismonte Daniel H. Fingerman Bobby T. Shih Mount & Stoelker, P.C. River Park Tower, 17th Floor 333 W. San Carlos St. San Jose, CA 95110 ***Counsel for:*** ***Askcs.com Inc.***
Adam Robert Alper David Allen York Latham & Watkins 135 Commonwealth Drive Menlo Park, California 94025 ***Counsel for:*** ***AP Net Marketing Inc.; ICS Inc.***	Rachel Krevans Jason A. Crotty Paul A. Friedman Morrison & Foerster LLP 425 Market Street San Francisco, California 94105-2482 ***Counsel for:*** ***Satellite LLC; Echostar Technologies Corporation; Echostar Communications Corporation***
David C. Doyle Morrison & Foerster LLP 3811 Valley Centre Dr., Suite 500 San Diego, California 92130 ***Counsel for:*** ***Echostar Technologies Corporation***	

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

Annemarie A. Daley Stephen P. Safranski Robins Kaplan Miller & Ciresi LLP 2800 LaSalle Plaza 800 LaSalle Avenue Minneapolis, Minnesota 55402 ***Counsel for:*** ***Coxcom, Inc.; Hospitality Network, Inc.***	Richard R. Patch J. Timothy Nardell Coblentz, Patch, Duffy & Bass LLP One Ferry Building, Suite 200 San Francisco, California 94111-4213 ***Counsel for:*** ***Coxcom, Inc.; Hospitality Network, Inc.***
Jeffrey H. Dean Kevin D. Hogg Bradford P. Lyerla Carl E. Myers Marshall Gerstein & Borun LLP 6300 Sears Tower 233 South Wacker Drive Chicago, Illinois 60606 ***Counsel for:*** ***Armstrong Group; Arvig Communication Systems; Charter Communications, Inc.; East Cleveland TV and Communications LLC; Massillon Cable TV, Inc.; Wide Open West LLC***	William R. Overend Morgan D. Tovey Reed Smith Crosby Heafey Two Embarcadero Center, Suite 2000 San Francisco, California 94111 ***Counsel for:*** ***Charter Communications, Inc.***
Daralyn J. Durie Joshua H. Lerner David J. Silbert Keker & Van Nest LLP 710 Sansome Street San Francisco, California 94111 ***Counsel for:*** ***Comcast Cable Communications, LLC; Insight Communications, Inc.***	Victor G. Savikas Kevin G. McBride Maria K. Nelson Marsha E. Mullin Jones Day 555 South Flower Street, 50th Floor Los Angeles, California 90071 ***Counsel for:*** ***DirecTV Group, Inc.***
Stephen E. Taylor Jan J. Klohonatz Taylor & Co. Law Offices, Inc. One Ferry Building, Suite 355 San Francisco, California 94111 ***Counsel for:*** ***Mediacom Communications Corporation***	Mitchell D. Lukin Baker Botts L.L.P. One Shell Plaza 910 Louisiana Houston, Texas 77022 ***Counsel for:*** ***Mediacom Communications Corporation; Bresnan Communications***
Jeffrey D. Sullivan Michael J. McNamara Baker Botts L.L.P. 30 Rockefeller Plaza New York, New York 10112 ***Counsel for:*** ***Mediacom Communications Corporation; Bresnan Communications***	Rebecca Anne Bortolotti John Christopher Reich Albert L. Underhill Merchant & Gould 80 S. 8th Street, Suite 3200 Minneapolis, Minnesota 55402 ***Counsel for: Arvig Communications Systems; Cannon Valley Communications, Inc.; Loretel Cablevision; Mid-Continent Media, Inc.; Savage Communications, Inc.; Sjoberg's Cablevision, Inc.; US Cable Holdings LP***

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

Sean David Garrison Robert Francis Copple Lewis & Roca LLP 40 N. Central Avenue Phoenix, Arizona 85004-4429 ***Counsel for:*** ***Cable America Corp.***	C. Mark Kittredge Perkins Coie Brown & Bain PA P.O. Box 400 Phoenix, Arizona 85001-0400 ***Counsel for:*** ***Cable One Inc.***
Troy Blinn Forderman George Chun Chen Bryan Cave LLP 2 N. Central Avenue, Suite 2200 Phoenix, Arizona 85004-4406 ***Counsel for:*** ***Cable System Service Inc.***	Gregory T. Spalj Fabyanske Westra & Hart PA 800 LaSalle Avenue, Suite 1900 Minneapolis, Minnesota 55402 ***Counsel for:*** ***Cable System Service, Inc.***
Patrick J. Whalen Spencer Fan Britt & Brown LLP 1000 Walnut Street, Suite 1400 Kansas City, Missouri 64106 ***Counsel for:*** ***NPG Cable Inc.***	Fritz Byers 824 Spitzer Building 520 Madison Avenue Toledo, Ohio 43604 ***Counsel for:*** ***Block Communications, Inc.***
Clay K. Keller Buckingham, Doolittle & Burroughs 50 South Main Street Akron, Ohio 44308 ***Counsel for:*** ***Nelsonville TV Cable, Inc.***	Melissa G. Ferrario Barry S. Goldsmith Gary H. Nunes Womble Carlyle Sandridge & Rice 8065 Leesburg Pike, Fourth Floor Tysons Corner, VA 22182 ***Counsel for:*** ***Nelsonville TV Cable, Inc.***
Christopher B. Fagan Fay Sharpe Fagan Minnich & McKee 1100 Superior Avenue, Seventh Floor Cleveland, Ohio 44114-2518 ***Counsel for:*** ***Armstrong Group; East Cleveland TV and Communications LLC; Massillon Cable TV, Inc.; Wide Open West, LLC***	Stephen S. Korniczky James V. Fazio Paul Hastings Janofsky & Walker LLP 3579 Valley Centre Drive San Diego, CA 92130 ***Counsel for:*** ***Cebridge Connections***
Benjamin Hershkowitz Goodwin Proctor LLP 599 Lexington Avenue New York, NY 10022 ***Counsel for:*** ***CSC Holdings, Inc.***	David S. Benyacar Daniel Reisner Kaye Scholar LLP 425 Park Avenue New York, NY 10022 ***Counsel for:*** ***Time Warner Cable, Inc.***

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA